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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,066	06/25/2003	Kohichiroh Maemura	2271/69634	6561
7590	12/31/2007		EXAMINER	
Ivan S. Kavrukov Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			SAFAIPOUR, HOUSHANG	
			ART UNIT	PAPER NUMBER
			2625	
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			12/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/607,066	MAEMURA, KOHICHIROH
	<b>Examiner</b>	<b>Art Unit</b>
	Houshang Safaipour	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 October 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4-7 and 10-17 is/are rejected.
- 7) Claim(s) 3,8 and 9 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### **1. *Response to Amendment***

Applicant's amendment filed on October 4, 2007 has been considered and made of record.

### **2. *Response to Arguments***

Applicant arguments with respect to the rejection of the claims have been considered but are moot in view of the new grounds of rejection necessitated by applicant's amendment of the claims.

#### ***Claim Rejections - 35 USC § 112***

##### **3. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "... an electronic mail address input device configured to input said electronic mail address designated when said electronic mail is transmitted to said transmission destination, in said electronic mail address memory..." There is no support in the specification.

#### ***Claim Rejections - 35 USC § 103***

##### **4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuji Makoto (JP 11-355347) and further in view of Cobb (US 6,199,102).

Regarding claims 1, 6 and 10 are Makato discloses a network facsimile, comprising:

- a facsimile function operative to communicate with facsimiles via a public network using a facsimile transmission procedure [0001];
- an electronic mail transmission function operative to transmit an electronic mail containing an image in a prescribed format to at least one transmission destination connected to a local or a wide area network [0001-0003];
- an electronic mail address memory configured to store an electronic mail address of a transmission destination when the network facsimile transmits an electronic mail to the transmission destination [0010];

Makota does not explicitly discloses an electronic mail address input device configured to input said electronic mail address, however, Cobb discloses a method and system for electronic messages (abstract) which creates an Acceptance List (105) and Blocking List (115), for the user to manually and/or automatically add or delete an address from the list (col. 8, lines 1-13). Therefore it would have been obvious to a person of ordinary skill in the art to use the method disclosed by Cobb as the method for the control of facsimile equipment taught by Makota in order to create, manually or automatically, a list of acceptable addresses in the memory for rejecting and discarding unacceptable emails.

an electronic mail scrap determination device configured to determine if a received electronic mail sent is to be scrapped when an electronic mail address or a domain assigned to the electronic mail has not been stored in the electronic mail address memory ([0008] lines 6-11); and

an electronic mail scrapping device configured to scrap the received electronic mail in accordance with a determination of the electronic mail scrap determination device ([0008] lines 1-13).

Regarding claim 2, Makato discloses the network facsimile according to claim 1, further comprising a checking objective selecting device configured to select one of an electronic mail address and a domain as a checking objective checked by the electronic mail scrap determination device (check verifies) the address and part of the domain against the address in permission domain address storage [0007]).

Regarding claim 4, Makato discloses the network facsimile according to any one of claims 1 to 3, further comprising: a scrap information storing device configured to store scrap information when the electronic mail is to be scrapped; and a scrap information checking device configured to check contents of the scrap information [0045].

Regarding claim 5, Makato discloses a network facsimile according to any one of claims 1 to 3, further comprising: a scrap information storing device configured to store scrap information when the electronic mail is to be scrapped; and a scrap information transmitting device configured to transmit the scrap information to a recipient of the electronic mail via any one of the networks [0009].

Regarding claim 7, Makato discloses the method according to claim 6, further comprising the step of selecting one of an electronic mail address and a domain as a checking objective in accordance with an electronic mail sender before performing the step of determining [0040-0043].

Regarding claims 12 and 15, the rejection under claim 1 also applies to claims 12 and 15. Furthermore, Cobb discloses that any subsequent email (second email) is verified against the Acceptance and Blocking Lists for proper processing (col. 8 lines 1-27).

Regarding claims 13, 14, 16 and 17, Cobb discloses moving suspected unwanted (junk) messages to a temporary or miscellaneous holding category for review and appropriate action (col. 3, lines 35-46 and col. 4 lines 59-63).

***Allowable Subject Matter***

6. Claims 3, 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipour whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Fri. from 6:00am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Houshang Safaipour  
Patent Examiner  
December 17, 2007

A handwritten signature in black ink, appearing to read "Houshang Safaipour". The signature is written in a cursive style with some vertical strokes and a diagonal flourish at the end.